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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/892,800
Filing Date: June 27, 2001
Appellant(s): BYERS ET AL.

Michael J. Persson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 23, 2009 appealing from the Office action mailed September 19, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection, which has been filed concurrently with the Appeal Brief, filed on June 23, 2009 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,970,475	BARNES	09-1999
2002/0065736	WILLNER ET AL.	5-2002
7,080,070	GAVARINI	7-2006
6,343,275	WONG	1-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Examiner notes that a first rejection was maintained (the combination of Barnes and Willner) and has included a second rejection (the combination of Barnes and Gavarini). As noted in the Final Rejection mailed on September 19, 2009, the second rejection was included based on the Declaration filed on March 24, 2008 under 37 CFR 1.131 if the appellant had shown facts in the Byer Declaration of completing the invention in this country or a NAFTA or WTO member.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 5, 9, 15-16, 18-19, 21-30, 32-33 and 35-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,970,475 to Barnes in view of U.S. Patent Application Publication No. 2002/0065736 to Willner et al.

Regarding claim 1, Barnes discloses a method for selling products over an electronic network, the method consisting of the steps of:

identifying a user (see at least col. 6, lines 38-40; col. 6, lines 45-48);

transmitting a user specific order entry form (old requisition request, Figure 1), the order entry form comprising at least one user specific product, a user specific price for the at least one product and a quantity entry field (see at least col. 6, lines 54-65; col. 9, lines 33-35; col. 9, lines 51-54; col. 19, lines 56-58; Figure 11), wherein the user specific order entry form comprises a user specific purchase history form comprising all products that were purchased (Repeat from an old Requisition Request 133, Figure 11);

receiving a quantity of at least one product entered into the quantity entry field by the user (see at least col. 18, lines 42-44; col. 21, lines 48-50, Figure 11);

transmitting a shopping cart comprising each of the at least one product selected by the user (see at least col. 18, lines 45-54; col. 22, lines 46-54; Figure 11; and

receiving an instruction from the user to process an order (see at least col. 22, lines 46-61; Figure 11).

However, Barnes does not explicitly disclose wherein the quantity entry field is the only field on the user specific order entry form in which entry of data by the user is required purchase the at least one product. Barnes discloses making a purchase and using a repeat from an old requisition request (Figure 11). The requisition request in Barnes is used as a purchase order to suppliers (col. 9, lines 33-34). The repeat from an old requisition request can be edited, which can include the quantity (Figure 11).

Willner, on the other hand, teaches the quantity entry field is the only field on the user specific order entry form in which entry of data by the user is required purchase the at least one product (Figure 6B; Figure 11; paragraph 20).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Barnes, to include the quantity entry field is the only field on the user specific order entry form in which entry of data by the user is required purchase the at least one product, as taught by Willner, in order to have an organized way of purchasing goods and services (Willner paragraph 9), thus providing an ordering method that is not a time-consuming process (paragraph 7).

Regarding claims 2-5, Barnes discloses the user specific entry form that further comprises an internal part number associated with at least one previously ordered product (see at least Ref. no. 133, Figure 11; col. 22, lines 48-49); and a user specific order entry form that further comprises at least one previously quoted product (see at least Figures 11-12; col. 22, lines 46-53).

Regarding claims 8, Barnes substantially discloses the claimed invention, however, Barnes does not disclose purchasing form comprises a total of the at least one previously ordered product that was purchased during the specified time period.

Barnes discloses all users can view status and history of orders and generate reports (see at least Figures 11-12; col. 22, lines 46-53). Furthermore, Barnes discloses the Bank server can provide various reports on Customer transactions, where all ACH transactions have a full event history (see at least col. 18, lines 23-30). Moreover, Barnes discloses the customer or buyer has access to select audit existing reports or access “user-defined reports” at which the user can define in a format that is useful to the user (see at least col. 23, lines 43-48). Willner, on the other hand, teaches the total of the at least one previously ordered product that was purchased during the specified time period (paragraphs 58-59; paragraph 70).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Barnes to include the total of the at least one previously ordered product that was purchased during the specified time period, as taught by Willner, in order to have an organize way of purchasing goods and services (Willner paragraph 9), thus providing an ordering method that is not a time-consuming process (paragraph 7).

Regarding claim 9, Barnes discloses an icon having a link to a product information order entry form (see at least col. 22, line 46-col. 23, line 22; Figures 9, 11-13).

Regarding claim 15, Barnes discloses a computer program product for selling products over an electronic network, the computer program product comprising:

means for identifying a user (see at least col. 6, lines 38-40; col. 6, lines 45-48);

means for transmitting a user specific order entry form (old requisition request, Figure 1), the order entry form comprising at least one user specific product, a user specific price for the at least one product and a quantity entry field (see at least col. 6, lines 54-65; col. 9, lines 33-35; col. 9, lines 51-54; col. 19, lines 56-58; Figure 11), wherein the user specific order entry form comprises a user specific purchase history form comprising all products that were purchased during a specified time period (Repeat from an old Requisition Request 133, Figure 11);

means for receiving a quantity of at least one product entered into the quantity entry field by the user (see at least col. 18, lines 42-44; col. 21, lines 48-50, Figure 11);

means for transmitting a shopping cart comprising each of the at least one product selected by the user (see at least col. 18, lines 45-54; col. 22, lines 46-54; Figure 11; and

means for receiving an instruction from the user to process an order (see at least col. 22, lines 46-61; Figure 11).

However, Barnes does not explicitly disclose wherein the specified time period and the quantity entry field is the only field on the user specific order entry form in which entry of data by the user is required purchase the at least one product. Barnes discloses making a purchase and using a repeat from an old requisition request (Figure 11). The requisition request in Barnes is used as a purchase order to suppliers (col. 9,

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lines 33-34). The repeat from an old requisition request can be edited, which can include the quantity (Figure 11).

Willner, on the other hand, teaches the specified time period and the quantity entry field is the only field on the user specific order entry form in which entry of data by the user is required purchase the at least one product (Figure 6B; Figure 11; paragraph 20; paragraph 59; paragraph 70).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the computer program product of Barnes, to include the quantity entry field is the only field on the user specific order entry form in which entry of data by the user is required purchase the at least one product, as taught by Willner, in order to have an organized way of purchasing goods and services (Willner paragraph 9), thus providing an ordering method that is not a time-consuming process (paragraph 7).

Regarding claims 16 and 18-19, Barnes discloses the user specific entry form that further comprises an internal part number associated with at least one previously ordered product (see at least Ref. no. 133, Figure 11; col. 22, lines 48-49); transmitting a user specific order template that further comprises a new product entry field (see at least Figures 11-12; col. 22, lines 46-53); and a user specific order template, the order template further comprising at least one previously quoted product (see at least Figures 11-12; col. 22, lines 46-53).

Regarding claims 21-22, Barnes substantially discloses the claimed invention, however, Barnes does not disclose means for displaying a date range form; means for receiving a data entered into the said data entry field by the user; and a total of the at

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least one previously ordered product that was purchased during the specified time period.

Barnes discloses a repeat old requisition request (Figure 11). Furthermore, Barnes discloses all users can view status and history of orders and generate reports (see at least Figures 11-12; col. 22, lines 46-53). Moreover, Barnes discloses the customer or buyer has access to select audit existing reports or access “user-defined reports” at which the user can define in a format that is useful to the user (see at least col. 23, lines 43-48). Willner, on the other hand, teaches means for displaying a date range form; means for receiving a data entered into the said data entry field by the user; and the total of the at least one previously ordered product that was purchased during the specified time period (paragraphs 58-59; paragraph 70).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Barnes to include the date range form; means for receiving a data entered; and the total of the at least one previously ordered product that was purchased during the specified time period, as taught by Willner, in order to have an organize way of purchasing goods and services (Willner paragraph 9), thus providing an ordering method that is not a time-consuming process (paragraph 7).

Regarding claims 23-25, Barnes discloses an icon having a link to a product information order entry form; an icon having a link to a peer review form; and an icon having a link to a product protocol form (see at least col. 22, line 46-col. 23, line 22; Figures 9, 11-13).

Regarding claims 26-28, Barnes discloses sort filed; transmitting a payment option form and receiving an instruction from the user to utilize a specified payment option; and transmitting a facility option form and receiving an instruction from the user to utilized a specified facility option (see at least col. 8, lines 36-61; col. 18, lines 42-55; col. 23, lines 36-43; col. 25, lines 26-40).

Regarding claims 29-30 and 32-33, the claims recite a system that are parallel in scope to claims 15-16 and 18-19 above and are rejected under similar grounds.

Regarding claims 35-36, the claims recite a system that are parallel in scope to claims 21-22 above and are rejected under similar grounds.

Regarding claims 37-42, the claims recite a system that are parallel in scope to claims 23-28 above and are rejected under similar grounds.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 5, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,970,475 to Barnes in view of U.S. Patent No. 7,080,070 to Gavarini.

Regarding claim 1, Barnes discloses a method for selling products over an electronic network, the method consisting of the steps of:

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identifying a user (see at least col. 6, lines 38-40; col. 6, lines 45-48);

transmitting a user specific order entry form (old requisition request, Figure 1), the order entry form comprising at least one user specific product, a user specific price for the at least one product and a quantity entry field (see at least col. 6, lines 54-65; col. 9, lines 33-35; col. 9, lines 51-54; col. 19, lines 56-58; Figure 11), wherein the user specific order entry form comprises a user specific purchase history form comprising all products that were purchased (Repeat from an old Requisition Request 133, Figure 11);

receiving a quantity of at least one product entered into the quantity entry field by the user (see at least col. 18, lines 42-44; col. 21, lines 48-50, Figure 11);

transmitting a shopping cart comprising each of the at least one product selected by the user (see at least col. 18, lines 45-54; col. 22, lines 46-54; Figure 11; and

receiving an instruction from the user to process an order (see at least col. 22, lines 46-61; Figure 11).

However, Barnes does not explicitly disclose wherein the quantity entry field is the only field on the user specific order entry form in which entry of data by the user is required purchase the at least one product. Barnes discloses making a purchase and using a repeat from an old requisition request (Figure 11). The requisition request in Barnes is used as a purchase order to suppliers (col. 9, lines 33-34). The repeat from an old requisition request can be edited, which can include the quantity (Figure 11).

Gavarini, on the other hand, teaches the quantity entry field is the only field on the user specific order entry form in which entry of data by the user is required purchase the at least one product (Figure 18; col. 8, lines 59-61).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Barnes, to include the quantity entry field is the only field on the user specific order entry form in which entry of data by the user is required purchase the at least one product, as taught by Gavarini, in order to modify the selected item quantities from the past transaction (Gavarini, col. 8, lines 60-61), resulting in a substantial savings in both time and administrative costs for both the customer and merchant (Gavarini, col. 9, lines 3-5)..

Regarding claims 2-5, Barnes discloses the user specific entry form that further comprises an internal part number associated with at least one previously ordered product (see at least Ref. no. 133, Figure 11; col. 22, lines 48-49); and a user specific order entry form that further comprises at least one previously quoted product (see at least Figures 11-12; col. 22, lines 46-53).

Regarding claim 9, Barnes discloses an icon having a link to a product information order entry form (see at least col. 22, line 46-col. 23, line 22; Figures 9, 11-13).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,970,475 to Barnes and U.S. Patent No. 7,080,070 to Gavarini as applied to claim 1 above, and further in view of U.S. Patent No. 6,343,275 to Wong.

Regarding claims 8, Barnes and Gavarini substantially disclose the claimed invention, however, the combination does not disclose a total of the at least one previously ordered product that was purchased during the specified time period.

The combination discloses all users can view status and history of orders and generate reports (Barnes, see at least Figures 11-12; col. 22, lines 46-53).

Furthermore, the combination discloses the Bank server can provide various reports on Customer transactions, where all ACH transactions have a full event history (Barnes, see at least col. 18, lines 23-30). Moreover, the combination discloses the customer or buyer has access to select audit existing reports or access “user-defined reports” at which the user can define in a format that is useful to the user (Barnes, see at least col. 23, lines 43-48). The combination discloses the use and modification of the selected item quantities from the past transaction (Gavarini, col. 8, lines 59-61). The customer can recall past transaction and use them as a template for the current order (Gavarini, col. 8, lines 65-66).

Wong, on the other hand, teaches the total of the at least one previously ordered product that was purchased during the specified time period (Figure 34; Figure 35 (35A-35D; col. 17, lines 21-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination to include the total of the at least one previously ordered product that was purchased during the specified time period, as taught by Wong, in order to find and display the products purchased within a specified time window of a specified date (Wong, col. 17, lines 24-25).

Claims 15-16, 18-19, 21-30, 32-33 and 35-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,970,475 to Barnes in view of

U.S. Patent No. 7,080,070 to Gavarini and in further view of U.S. Patent No. 6,343,275 to Wong.

Regarding claim 15, Barnes discloses a computer program product for selling products over an electronic network, the computer program product comprising:

means for identifying a user (see at least col. 6, lines 38-40; col. 6, lines 45-48);

means for transmitting a user specific order entry form (old requisition request, Figure 1), the order entry form comprising at least one user specific product, a user specific price for the at least one product and a quantity entry field (see at least col. 6, lines 54-65; col. 9, lines 33-35; col. 9, lines 51-54; col. 19, lines 56-58; Figure 11), wherein the user specific order entry form comprises a user specific purchase history form comprising all products that were purchased during a specified time period (Repeat from an old Requisition Request 133, Figure 11);

means for receiving a quantity of at least one product entered into the quantity entry field by the user (see at least col. 18, lines 42-44; col. 21, lines 48-50, Figure 11);

means for transmitting a shopping cart comprising each of the at least one product selected by the user (see at least col. 18, lines 45-54; col. 22, lines 46-54; Figure 11; and

means for receiving an instruction from the user to process an order (see at least col. 22, lines 46-61; Figure 11).

However, Barnes does not explicitly disclose wherein the specified time period and the quantity entry field is the only field on the user specific order entry form in which entry of data by the user is required purchase the at least one product. Barnes

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discloses making a purchase and using a repeat from an old requisition request (Figure 11). The requisition request in Barnes is used as a purchase order to suppliers (col. 9, lines 33-34). The repeat from an old requisition request can be edited, which can include the quantity (Figure 11).

Gavarini, on the other hand, teaches the quantity entry field is the only field on the user specific order entry form in which entry of data by the user is required purchase the at least one product (Figure 18; col. 8, lines 59-61).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Barnes, to include the quantity entry field is the only field on the user specific order entry form in which entry of data by the user is required purchase the at least one product, as taught by Gavarini, in order to modify the selected item quantities from the past transaction (Gavarini, col. 8, lines 60-61), resulting in a substantial savings in both time and administrative costs for both the customer and merchant (Gavarini, col. 9, lines 3-5).

Wong, on the other hand, teaches the total of the at least one previously ordered product that was purchased during the specified time period (Figure 34; Figure 35 (35A-35D; col. 17, lines 21-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination to include the total of the at least one previously ordered product that was purchased during the specified time period, as taught by Wong, in order to find and display the products purchased within a specified time window of a specified date (Wong, col. 17, lines 24-25).

Regarding claims 16 and 18-19, Barnes discloses the user specific entry form that further comprises an internal part number associated with at least one previously ordered product (see at least Ref. no. 133, Figure 11; col. 22, lines 48-49); transmitting a user specific order template that further comprises a new product entry field (see at least Figures 11-12; col. 22, lines 46-53); and a user specific order template, the order template further comprising at least one previously quoted product (see at least Figures 11-12; col. 22, lines 46-53).

Regarding claims 21-22, Barnes substantially discloses the claimed invention, however, Barnes does not disclose means for displaying a date range form; means for receiving a data entered into the said data entry field by the user; and a total of the at least one previously ordered product that was purchased during the specified time period.

Barnes discloses a repeat old requisition request (Figure 11). Furthermore, Barnes discloses all users can view status and history of orders and generate reports (see at least Figures 11-12; col. 22, lines 46-53). Moreover, Barnes discloses the customer or buyer has access to select audit existing reports or access "user-defined reports" at which the user can define in a format that is useful to the user (see at least col. 23, lines 43-48).

Gavarini, on the other hand, teaches means for receiving a data entered into the said data entry field by the user (Figure 18; col. 8, lines 59-61).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Barnes, to include the means for receiving

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a data entered into the said data entry field by the user, as taught by Gavarini, in order to modify the selected item quantities from the past transaction (Gavarini, col. 8, lines 60-61), resulting in a substantial savings in both time and administrative costs for both the customer and merchant (Gavarini, col. 9, lines 3-5).

Wong, on the other hand, teaches means for displaying a date range form; and a total of the at least one previously ordered product that was purchased during the specified time period (Figure 34; Figure 35 (35A-35D; col. 17, lines 21-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Barnes, to include means for displaying a date range form; and a total of the at least one previously ordered product that was purchased during the specified time period, a taught by Won, in order to find and display the products purchased within a specified time window of a specified date (Wong, col. 17, lines 24-25).

Regarding claims 23-25, Barnes discloses an icon having a link to a product information order entry form; an icon having a link to a peer review form; and an icon having a link to a product protocol form (see at least col. 22, line 46-col. 23, line 22; Figures 9, 11-13).

Regarding claims 26-28, Barnes discloses sort filed; transmitting a payment option form and receiving an instruction from the user to utilize a specified payment option; and transmitting a facility option form and receiving an instruction from the user to utilized a specified facility option (see at least col. 8, lines 36-61; col. 18, lines 42-55; col. 23, lines 36-43; col. 25, lines 26-40).

Regarding claims 29-30 and 32-33, the claims recite a system that are parallel in scope to claims 15-16 and 18-19 above and are rejected under similar grounds.

Regarding claims 35-36, the claims recite a system that are parallel in scope to claims 21-22 above and are rejected under similar grounds.

Regarding claims 37-42, the claims recite a system that are parallel in scope to claims 23-28 above and are rejected under similar grounds.

(10) Response to Argument

Preliminary Note: The Examiner has adopted Appellant's outline format for use in addressing Appellants' arguments.

(1) The Taylor Declaration is a Valid Evidence in Support of Applicants' Arguments Rebutting the Examiner's Asserted Prima facie Case of Obviousness.

Appellant remark that "the Examiner does not challenge Mr. Taylor as a declarant. Thus, the Taylor Declaration should have been considered by the Examiner as evidence in support of the Applicant's arguments in rebuttal of the Examiner's asserted prima facie showing of obviousness" (Argument section page 15, first bridging)

Examiner has challenged the Mr. Taylor as a declarant and has also challenged Mr. Taylor's Declaration. As stated in the Final Office Action mailed on September 19, 2008, "The Examiner takes note of the fact that the Declaration of Kenneth R. Taylor only offers an opinion that the claims are patentable. Although factual evidence is preferable to opinion testimony, such testimony is entitled to consideration and some

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weight so long as the opinion is not on the ultimate legal conclusion at issue. Mr. Taylor's declaration of "I declare that the Barnes references does not disclose or suggest a user specific purchase history I declare that a repeat of an old requisition request..." in paragraph 5;" I would not be motivated to modify the Barnes reference..." in paragraph 6; "I would not be motivated to combine the Barnes and Willner references... I declare that each of these ways of placing an order is time consuming..." in paragraph 7; "I declare that the Willner references teaches away... I declare that, were such a feature included or suggested that there would be no need for the compatibility check..." in paragraph 8; and "I declare that a method...It is my belief that the applicants...It is likewise by belief..." in paragraph 9 are opinions that are legal conclusion and lack factual support. Therefore, the Declaration was found not to be persuasive because the opinions are legal conclusions and lack factual support. If the only facts of record pertaining to the level of skill in the art are found within the prior art of record, the court has held that an invention may be held to have been obvious without a specific finding of a particular level of skill where the prior art itself reflects an appropriate level. *Chore-Time Equipment, Inc. v. Cumberland Corp.*, 713 F.2d 774, 218 USPQ 673 (Fed. Cir. 1983). See also *Okajima v. Bourdeau*, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001).

Furthermore, Mr. Taylor's declaration does not include statements of evidence of unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. (See 716.01(c)).

(2) The Taylor Declaration Neither States Legal Conclusions Nor Lacks

Factual Support.

Appellant remarks "the Taylor Declaration neither states legal conclusions nor lacks factual support. As there are no further objections to the Taylor Declaration, it should have been given due consideration to overcome the Examiner's asserted *prima facie* case for obviousness". (Argument section, pages 20-21, third paragraph)

As stated above and as stated in the Final Office Action mailed on September 19, 2008, "The Examiner takes note of the fact that the Declaration of Kenneth R. Taylor only offers an opinion that the claims are patentable. Although factual evidence is preferable to opinion testimony, such testimony is entitled to consideration and some weight so long as the opinion is not on the ultimate legal conclusion at issue. Mr. Taylor's declaration of "I declare that the Barnes references does not disclose or suggest a user specific purchase history I declare that a repeat of an old requisition request..." in paragraph 5; "I would not be motivated to modify the Barnes reference..." in paragraph 6; "I would not be motivated to combine the Barnes and Willner references... I declare that each of these ways of placing an order is time consuming..." in paragraph 7; "I declare that the Willner references teaches away... I declare that, were such a feature included or suggested, that there would be no need for the compatibility check..." in paragraph 8; and "I declare that a method...It is my belief that the applicants...It is likewise by belief..." in paragraph 9 are opinions that are legal conclusion and lack factual support. Therefore, the Declaration was found not to be persuasive because the opinions are legal conclusions and lack factual support. If the

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only facts of record pertaining to the level of skill in the art are found within the prior art of record, the court has held that an invention may be held to have been obvious without a specific finding of a particular level of skill where the prior art itself reflects an appropriate level. *Chore-Time Equipment, Inc. v. Cumberland Corp.*, 713 F.2d 774, 218 USPQ 673 (Fed. Cir. 1983). See also *Okajima v. Bourdeau*, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001).

Furthermore, Mr. Taylor's declaration does not include statements of evidence of unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. (See 716.01(c)). For example, Mr. Taylor has provided no evidence of commercial success, except for his own testimony. Furthermore, Mr. Taylor has provided no nexus between any evidence of commercial success and the claimed invention. Alternatively, he provides his opinion-based-allegation that the references do not disclose or suggest or teach away from the claimed invention. Mr. Taylor has provided no objective evidence of nonobviousness including any evidence or proof of commercial success attributable to the invention defined by the claims. MPEP 716.03(b) states that the commercial success must be derived from the claimed invention. Mr. Taylor declaration does not provide objective evidence that an art recognized problem existed in the art for a long period of time without solution. Moreover, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the

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above cited reference, they would still be unable to solve the problem. See MPEP § 716.04. The relevance of long-felt need and the failure of others to the issue of obviousness depend on several factors was not provided by Mr. Taylor's declaration. Long-felt need is analyzed as of the date the problem is identified and articulated, and there must be evidence of efforts to solve that problem. This testimony does not provide evidence to identify the date the problem was identified and articulated. Furthermore, this testimony provides no evidence of efforts to solve the problem or unsuccessful attempts to solve the problem. Moreover, Mr. Taylor's declaration does not provide evidence that is unexpected and significant. The evidence relied upon should establish "that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance." Mr. Taylor's testimony appears to be mere opinion evidence or conclusions by appellant.

**The Taylor Declaration's Statements Overcome the Examiner's Asserted
Prima facie Case of Obviousness and Place the Application in Condition of
Allowance.**

Appellant remarks that "the Applicants assert that none of the references cited by the Examiner discloses or suggests a user specific purchase history form comprising all products that were purchased during a specified time period, that there is no suggestion or motivation, either in the references themselves or in the knowledge of those of ordinary skill in the relevant art, to modify the Barnes reference to include such a feature, and that such a combination would be unlikely to be successful". (Argument section, page 24-25, fourth paragraph)

Examiner does not agree. The combinations of Barnes and Willner and Barnes and Gavarini teach or suggest “a user specific purchase history form comprising all products that were purchased during a specified time period”. As stated in the Final Office Action dated March 23, 2005, Barnes discloses making a purchase and using a repeat from an old requisition request (Figure 11). The requisition request in Barnes is used as a purchase order to suppliers (col. 9, lines 33-34), where the order includes product and services that the user wants to purchase (col. 28, lines 6-7). The repeat from an old requisition request can be edited, which can include the quantity (Figure 11). Such repeat from an old requisition request is considered “a user specific purchase history form comprising all products that were purchased during a specified time period”. The Examiner then turns to Willner and Gavarini to teach the quantity entry field.

In response to appellant’s argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation was found in Willner “in order to have an organize way of purchasing goods and services (Willner paragraph 9), thus providing an ordering method that is not a time-consuming process (Willner, paragraph 7) and Gavarini “in order to modify selected

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item quantities from the past transaction (Gavarini, col. 8, lines 60-61), resulting in a substantial savings in both time and administrative costs for both the customer and merchant (Gavarini, col. 9, lines 3-5). Furthermore, KSR forecloses Appellant's remark that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. KSR, 82 USPQ2d at 1396 (2007)

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Marissa Thein/
Examiner, Art Unit 3627

Conferees:

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627

Alexander Kalinowski/A.K./

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